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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,320	02/06/2001	Patrick Page	1103326-0654	3650

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WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 10/09/2002

#9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/762,320

Applicant(s)

Page

Examiner
Maurie G. Baker, Ph.D.

Art Unit
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-16 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

Please also note: In an effort to enhance communication with our customers and reduce processing time, Group 1639 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. The "Petition for Withdrawal of Premature Office Action" (filed via facsimile on July 30, 2002) is noted. In this Petition, applicant notes that "examination must not begin before May 22, 2002" (page 3). As it is now *after* May 22, 2002, the Petition is moot and the following action is set forth.
2. The action below mirrors the previous action mailed April 5, 2002. However, applicant's Preliminary Amendment filed June 6, 2002 has now been entered. Claims 1-15 were amended and claim 16 was added in this amendment. Thus claims 1-16 are now under consideration.

Election/Restriction

3. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

4. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention from the following groups to which the claims must be restricted.

- I. Claims 1-5 and 13, drawn to a functionalized polymeric reagent and a kit.
- II. Claims 6-8, drawn to a method for preparing a functionalized polymeric reagent.
- III. Claims 9-12, drawn to a method for preparing an organic compound.
- IV. Claims 14-16, drawn to compounds of Formula II.

5. The inventions listed as Groups I – IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons that follow.

6. First, there does not appear to be a technical feature that links the claims of Group IV to the rest of the claims as there is no requirement that the specific compounds of this group be used in processes to make the reagents claimed in Group I. Moreover, the technical feature of Group IV is the compound of Formula II, while the technical feature that links all of the rest of the claims is the “functionalized polymeric reagent”. However, even if applicant argues that the Groups have a common technical feature, this feature is known in the art as disclosed by Short et al (see paragraphs 7-8 below).

7. The technical feature that links the claims of Groups I – III is the “functionalized polymeric reagent”. The groups lack unity because the claimed functionalized polymeric reagents are known in the art as disclosed by Short et al (Tet. Lett. 1997, 38(3), pp. 359-362). This reference is described below.

8. Short et al disclose a polymer supported isocyanide (isonitrile) reading on claim 1 (see Scheme 3 of the reference). Specifically, this polymeric reagent is an isocyanide (reading on the claimed “acid labile isonitrile moiety”) bound to a Wang resin (reading on the claimed polymer). The polymer bound compounds of Short et al are reacted with ω -ketoacids, and then ultimately cleaved from the resin with TFA (trifluoroacetic acid), which meets the “acid-labile” requirement of the claim (see Short et al, page 360). Moreover, the polymer supported isocyanides of Short et al are used in a method of solid-phase synthesis that reads on the instant claim 9. See Scheme 3 of the reference where the reaction and then further cleavage from the resin is disclosed.

9. Also, the products of Groups I and IV are different in structure and their modes of action and chemical reactivity would be different. Further, they represent separate and distinct products (different inventive concepts). They differ in respect to their properties, the synthetic methodology for making them and/or their use. The inventions of Groups II and III also represent different inventive concepts as they represent different methods, with different steps, different reagents and/or different end results.

10. Moreover, see MPEP 1850: Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By “dependent” claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

11. See 37 CFR § 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage, cited in part below (especially sections (c) and (d)).

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of

the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

12. Also from MPEP 1850: In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process, it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

13. The instant international application contains multiple products and methods, where the feature that links the claims with respect to the “first invention of the category first mentioned in the claims” is known in the art, as set forth above. Thus, the instant claims lack unity of invention. For these reasons, election under these rules is proper and required.

14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
October 7, 2002

A handwritten signature in black ink, consisting of stylized, cursive letters that appear to be 'MB' followed by a long horizontal flourish.

MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER